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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/196,524 11/20/98 JESSOP

P 3517.1

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IM62/0324

EXAMINER

HANDY, D

ART UNIT

PAPER NUMBER

1743

DATE MAILED:

03/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/196,524

Applicant(s)
Jessop et al.

Examiner
Dwayne K. Handy

Group Art Unit
1743



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1 _____ is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☒ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

Specification

1. The disclosure is objected to because of the following informalities:

On page 2, line 1 of the specification, applicant refers to "35 U.S.C 1.19(e)". This should read "35 U.S.C. 119(e)". Also, on page 7, line 2, applicant refers to "The plate 10". This element has been labeled "20" elsewhere in the specification and in the drawings. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter

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which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites the use of a transfer member which has an under surface that is spaced from and not connected to the receiving plate. However, on page 10, line 6 of the specification where the operation of their system is described, the applicant states that "transfer member 30 is urged onto the uppermost receiving plate 20 of stack 66".

Also, when first describing how to operate the system, applicant (p. 7, lines 2-4) states that "The plate 10 with pipette tips is transferred to the holding tray 70 using the transfer tool as hereinafter discussed." But later, on page 10, lines 5-21 (also shown in Figure 8), applicant clearly states that the operator grasps the receiving plate 20 with a thumb and index finger. Since the transfer member does not touch the receiving plate (as stated in claim 1), and the receiving plate is lifted by the operator (not the transfer member), the examiner fails to see how the transfer member itself could possibly be used to transfer the receiving plate in anyway. Thus, claim 1 is rejected.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Scaramella et al.

Scaramella et al. shows a system for positioning pipette tips in a dispensing tray which has a receiving plate (Figures 1 and 8, element #22) with a plurality of apertures sized for pipette tips and the apertures arranged to correspond to openings in an upper wall of a dispensing tray.

Scaramella also shows a transfer member (Figure 4, #29) for engaging the pipette tips with an under surface not connected to the receiving plate. The transfer member has a plurality of projections extending from the under surface, with the projections arranged to correspond to receiving plate apertures, sized to fit a top opening of each pipette and for holding the pipette tip in alignment for positioning through the openings of the dispensing tray.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Ward. Ward shows a system for positioning pipette tips in a dispensing tray which has a receiving plate (Figure 6, element #82) with a plurality of apertures (#81) sized for pipette tips and the apertures arranged to correspond to openings in an upper wall of a dispensing tray. Scaramella also shows a transfer member (Figures 3 and 4, #24) for engaging the pipette tips with an under surface not connected to the receiving plate. The transfer member has a plurality of projections extending from the under surface (Figures 3 and 4, #96), with the projections arranged to correspond to receiving

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plate apertures, sized to fit a top opening of each pipette and for holding the pipette tip in alignment for positioning through the openings of the dispensing tray (#28).

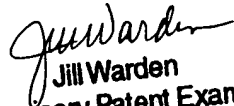
6. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Astle. Astle shows a system for positioning pipette tips in a dispensing tray which has a receiving plate (Figures 2 and 3, element #30) with a plurality of apertures (#50) sized for pipette tips and the apertures arranged to correspond to openings in an upper wall of a dispensing tray. Scaramella also shows a transfer member (Figures 3 and 4, #24) for engaging the pipette tips with an under surface not connected to the receiving plate. The transfer member has a plurality of projections extending from the under surface (Figures 8, #130 - also column 4, lines 63-64), with the projections arranged to correspond to receiving plate apertures, sized to fit a top opening of each pipette and for holding the pipette tip in alignment for positioning through the openings of the dispensing tray.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Freeman et al. (P.N. 5,063,790), Hirsch (5,190,727) and Shaw (5,576,214) each contain transfer members with projections for engaging pipette tips and moving the pipette tips.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (703)-305-0211.


Jill Warden
Supervisory Patent Examiner
Technology Center 1700

dkh

March 22, 2000